

REMARKS

Applicant includes with this amendment newly provided claims 17 and 18 depending from amended claim 16. These two claims are similar in breadth to claims 2 and 10. No new matter has been added. Applicant believes that no additional fees are required. However should this not be the case then the Commissioner is authorized to access Applicant's Agent's Deposit Account No. 08-3255 to make this adjustment.

Applicant also encloses herewith the Declaration of Mr. Robert Davies, P. Eng., as evidence in support of the arguments presented herein. The Declaration of Mr. Davies is hereby incorporated by reference in its entirety into this response as if its entire contents were contained herein.

Claims 1, 2, 10 and 16 now stand rejected under 35 U.S.C. 102(b) as allegedly being anticipated by Morgan ('295). The Examiner alleges that Morgan teaches a window frame with a jamb pocket portion containing a retractable mesh screen (26) rolled onto a spring-biased cassette with a handle (28) extending along the bottom portion of the screen (26) and guided along grooves (39) as the screen (26) is moved to a closed position. Applicants completely disagree for the reasoning that follows.

Before commencing any rebuttal with reference to any alleged prior art the Examiner is respectfully directed towards the following excerpted case law from which Applicant will draw liberally with respect to anticipation and obviousness.

ANTICIPATION

The following excerpts of U.S. case law represent Applicant's understanding of the test for novelty.

In Hybritech Inc. v. Monoclonal Antibodies, Inc., 802 F.2d 1367, 231 U.S.P.Q. 81, 90 (Fed. Cir. 1986) ("It is axiomatic that for prior art to anticipate under § 102 it has to meet every element of the claimed invention, and that such a determination is one of fact.").

In re Donohue, 766 F.2d 531, 226 U.S.P.Q. 619, 621 (Fed. Cir. 1985) ("an anticipation rejection requires a showing that each limitation of a claim must be found in a single reference, practice, or device.").

In Atlas Powder Co. v. E.I. du Pont De Nemours & Co., 750 F.2d 1569, 1574, 224 U.S.P.Q. 209, 411 (Fed. Cir. 1984) ("exclusion of a claimed element from a prior art reference is enough to negate anticipation by that reference").

In Tights, Inc. v. Acme-McCrary Corp., 541, F.2d 1047, 191 U.S.P.Q. 305 (4th Cir. 1976); Saf-Gard Prods., Inc. v. Service Parts, Inc., 532 F.2d 1266, 190 U.S.P.Q. 455 (9th Cir. 1976); Shanklin Corp. v. Springfield Photo Mount Co., 521 F.2d 609, 187 U.S.P.Q. 129 (1st Cir. 1975) ("To anticipate under section 102, a prior art reference must disclose all the elements of the claimed invention or their equivalents functioning in essentially the same way.").

In re Beno (1985) 768 F.2d 1340, 226 U.S.P.Q. 683 (Fed. Cir. 1985) a prior art patent or published application is a reference only for that which it teaches.

In re Sun, 31 USPQ 2d 1451, 1453 (Fed. Cir. 1993) (unpublished)

Under section 102(b), anticipation requires that the prior art reference disclose, either expressly or under the principles of inherency, every limitation of the claim. . . .

But to be prior art under section 102(b), a reference must be enabling. . . . **That is, it must put the claimed invention in the hand of one skilled in the art (emphasis added).** . . . The examiner bears the burden of presenting at least a prima facie case of anticipation.

Helifix Ltd. v. Blok-Lok, Ltd., 54 USPQ 2d 1299, 1304 (Fed. Cir. 2000)

"[E]ven if the claimed invention is disclosed in a printed publication, that disclosure will not suffice as prior art if it was not enabling." *Donohoe*, 766 F.2d at 533, 226 USPQ at 621.

In re Wilder, 166 USPQ 545, 548 (C.C.P.A. 1970)

Simply stated, a prior publication or patent description will be considered as anticipatory when its disclosure is at once specific and enabling with regard to the particular subject matter at issue. . . . However, such disclosure may yet be held not to legally anticipate the claimed subject matter if it is found not to be sufficiently enabling, in other words, if **it does not place the subject matter of the claims within “the possession of the public.”** (emphasis added)

Ciba-Geigy Corp. v. Alza Corp., 37 USPQ 2d 1337, 1341 n.3 (Fed. Cir. 1995) (unpublished)

An anticipatory reference must be enabling, *see Akzo N.V. v. United States Int'l Trade Comm'n*, 808 F.2d 1471, 1479, 1 U.S.P.Q.2D (BNA) 1241, 1245 (Fed. Cir. 1986), *cert. denied*, 482 U.S. 909, 96 L. Ed. 2d 382, 107 S. Ct. 2490 (1987), so as to place one of ordinary skill in possession of the claimed invention. *In re Spada*, 911 F.2d 705, 708, 15 U.S.P.Q.2D (BNA) 1655, 1657 (Fed. Cir. 1990); *see Seymour v. Osborne*, 78 U.S. 516, 555, 20 L. Ed. 33 (1870) ("The knowledge supposed to be derived from the publication must be sufficient to enable those skilled in the art or science to understand the nature and operation of the invention.").

OBVIOUSNESS

The traditional test enunciated in *Graham vs. John Deere Company* 383 U.S. 1, 148 U.S.P.Q. 459 1966, for Section 103 nonobviousness requires the fact finder to make several determinations. The test provides that the scope and content of the prior art be determined, the differences between the prior art and the claims at issue be ascertained, and the level of ordinary skill in the pertinent art be resolved. Thus, the patentability of the claims at hand must stem from the fact that the specific combination of the claimed elements was not disclosed in the prior art and the additional allegation **that the specific combination of claimed elements** (emphasis added) was nonobvious to one of ordinary skill in the art.

Clearly, the prior art does not suggest or provide any reason or motivation to make such a modification as purported by the Examiner. With reference to In Re: Regal, 526 F. 2d 1399, 1403 n. 6, 188 USPQ 136, 139 n. 6 (CCPA 1975).

"There must be some logical reason apparent from positive, concrete evidence of record which justifies a combination of primary and secondary references".

In Re: Geiger, 815 F. 2d 686, 688, 2 USPQ 2d 1276, 1278 (Fed. Cir. 1987) (obviousness can not be established by combining pieces of prior art absence some "teachings, suggestion, or incentive supporting the combination"): In Re: Cho, 813 F. 2d 378, 382, 1 USPQ 2d 1662, 1664 (Fed. Cir. 1987)("discussing the Board's holding that the artisan would have been motivated to combine the references").

Therefore, it Applicant's view there is no evidence of motivation in the prior art, either within the references themselves, or knowledge generally available to one of ordinary skill in the art, to make the purported changes suggested by the Examiner to arrive at the claimed subject matter.

Respectfully, the Examiner is creating a 20/20 hindsight reconstruction using Applicant's invention as a blue print to allegedly find elements of Applicant's combination in the prior art. This is not permissible as set out below.

In re Oetiker, 24 USPQ 2d 1443, 1446 (Fed. Cir. 1992)

The combination of elements from non-analogous sources, in a manner that reconstructs the applicant's invention only with the benefit of hindsight, is insufficient to present a prima facie case of obviousness. **There must be some reason, suggestion, or motivation found in the prior art whereby a person of ordinary skill in the field of the invention would make the combination.** (emphasis added) That knowledge can not come from the applicant's invention itself.

ATD Corporation v. Lydall, Inc., 48 USPQ 2d 1321, 1329 (Fed. Cir. 1998)

Determination of obviousness can not be based on the hindsight combination of components selectively culled from the prior art to fit the parameters of the

patented invention. **There must be a teaching or suggestion within the prior art, or within the general knowledge of a person of ordinary skill in the field of the invention, to look to particular sources of information, to select particular elements, and to combine them in the way they were combined by the inventor.(emphasis added)**

In Re: Fritch, 23 U.S.P.Q. 2d 1780 (Fed. Cir. 1992)

“Wilson and Hendrix fail to suggest any motivation for, or desirability of, the changes espoused by the Examiner and endorsed by the Board. Here, the Examiner relied upon hindsight to arrive at the determination of obviousness. **It is impermissible to use the claimed invention as an instruction manual or “template” to piece together the teachings of the prior art so that the claimed invention is rendered obvious(emphasis added).** The court has previously stated that “[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.”

Referring now to United States Patent 2,235,295 hereinafter referred to as Morgan there is taught a window frame with a screen permanently installed above the header for a double sash type window as best seen in Figure 2. The screen is effectively placed into a space provided above the header of Morgan. Once the screen is installed it is difficult to remove.

The Examiner makes the basic assumption that the jamb pocket portion defined in the claims is an alleged equivalent to the header space 24 of the Morgan structure. But one skilled in the art would appreciate that Morgan's screen is in fact permanently installed in the header section 24 of Morgan, which would require disassembly for repair, as stated in the Declaration of Mr. Davies. There is no teaching within Morgan as to how the screen 25 in space 24 is maintained. At column 2, second paragraph Morgan states that a roller 25 is mounted in chamber 24 which carries the screen element 26 which may be rolled and unrolled in a manner of a conventional window shade. In support of these statements made with respect to Morgan Applicants provide herewith the Declaration of Mr. John Robert Davies, P. Eng. (a co-inventor) and a person skilled in the art. Again the contents of his declaration in its entirety are incorporated by reference into the response as if they were completely presented herein.

The screen element of Morgan passes through a pair of horizontal channel pieces 27 which are supported and fastened between the facing member 16 and frame member 13 by unlabelled screw

possible but not practical. If the Morgan window is installed on the second floor of the home it must also be disassembled in order to access the screen.

There is no detail provided in Morgan as to how the screen is mounted though I am presuming that it is mounted conventionally like a roll-out blind. I must conclude that the screen of Morgan is considered to be a relatively permanent screen in view of the text in Morgan (see page 2 left column at line 24-27). In order to disassemble Morgan one would have to remove, any caulking, trim Y and siding X from the construction of the window and scrap any paint over the screws whether at the ground level or whether on the second floor and accessed by a ladder. Secondly I believe that the screening of Morgan is a metal screening since fabric screening was not available until after the application for Morgan was submitted in April 1940.

I also note that the guide strips 27 are held in place as well by screws within members 16 and 13 and would also have to be removed in order to disassemble Morgan to access the screen. The unlabelled trim section Y and siding X above board 16 will also have to be removed before removing board 16. These strips 27 are held in place in order to provide a bearing surface for the wire screen cloth, which is metal, of Morgan to easily run over these bearing surfaces 27 rather than over wood. In order to remove board 16 from the assembly, once Morgan scrapes off the paint from the board 16 and removes screws or nails and pries off the board (without cracking it) having already removed trim Y and siding X (Morgan would have to initially somehow remove these items whether in fact they are wood or sheet metal). The trim piece Y is a rain cap installed below the siding X as seen in Figure 2 above, which sits upon the upper edge of board 16. So ultimately in order to remove board 16 one would have to remove the sheet metal siding piece X above the trim piece Y which also must be removed which then provides access to the board 16.

Presuming Morgan is successful he is then able to remove the screen from its mounting presuming the mounting is the same as a roll-out blind. Otherwise, there are no details as to the mounting of the spring-biased screen. Once the screen and roller are removed from the area 24 of Morgan and presuming that the screen can be repaired or replaced, one now faces the need to reinstall a screen 25 within the space 24. Placing the screen on its roller on the mounting should be simple. The free end of the screen and handle portion 28 would then have to be pulled past the bearing surface 27 and the board 16 would then be remounted in place, presuming it could be mounted in place along with the necessary sealing, caulking and painting steps required. The trim piece Y above board 16 would then be reinstalled and caulked and finally the siding piece X would be reinstalled on that trim piece and sealed as necessary.

In my opinion therefore Morgan has not provided a practical means for replacing and repairing the screen 25 in his assembly. If paint has to be scraped off of the facing of board 16 then one would have to allow for resealing and repainting that board. If the board cracks during removal then it will have to be replaced. If the window assembly is on the second floor all the work above-mentioned will have to be done from the outside of the window, as board 16 faces the outside as taught in Morgan, and secondly that repair would have to be made on a ladder. I also assume that in replacing the screen of Morgan that because there is no teaching as to how the spring tension within the roller assembly of Morgan would be held while repairing the metal screen cloth, that the screen of Morgan would be removed and replaced with an equivalent spring loaded screen assembly and the unit in need of repair would then be repaired at a shop or the like.

Another comment I would like to make is that the Morgan structure provides no latch or lock at the bottom of the assembly as best seen in Figures 3 and 4.

instruction as to how to replace the screen assembly beyond that which I have expressed above from my analysis of the '295 Patent.

So contrary to the Examiner's views expressed in the action of May 25, 2006, which I have reviewed and attached to this my declaration, it is clear to me that Morgan cannot be easily disassembled (and subsequently reassembled by the way) as asserted by the Examiner. Morgan teaches a double hung window assembly that includes counterweights, no doubt of the rope type including iron weights or the like, but the details of this are not disclosed. Morgan was never designed to easily replace the screen assembly. The Morgan screen assembly clearly does reside in a space built above the header. But I believe that header of Morgan is actually board 13. The space 24 is therefore not within the header which one might argue that the space 24 is defined above the header 13.

Space 24 clearly is not equivalent to the pocket defined by Applicants' claims as amended because Applicants pocket is defined as being an integral one piece unit manufactured with the jamb when the jamb of the window frame is formed. Clearly this structure cannot be considered equivalent to Morgan since Morgan is made from wooden boards which are essentially fastened together by nails and screws in a conventional manner. The screen of Morgan passes between the pair of horizontal channel pieces 27 which must be removed in order for reinforcing strip 28 and the screen cloth to be fully accumulated on Morgan's roller prior to removal. In normal operation handle 28 will not pass through member 27. To do so the board 16 of Morgan and related trim parts must be removed from the Morgan assembly. Otherwise the screen cannot be repaired or cleaned, if punctured, torn or dirty. These details are clearly set out in the Declaration of Mr. Robert Davies. Again the teachings of Morgan are silent with respect to how his screen would be maintained in his assembly.

If one skilled in the art would to attempt to access the screen 25 from the outside of Morgan's window it would take a considerable amount of disassembly of Morgan's wooden window frame. It would be difficult to do in that many separate members must be disassembled in order to access the screen. Please refer to Mr. Davies Declaration in this regard. The real question is

once disassembled could Morgan be easily reconstructed. Further, normally one would not attempt to repair the screen from the inside. Any attempt to repair would be made from the outside. Morgan himself teaches inner and outer guideways 20 and 19 thereby defining the inside and outside faces of his window.

Morgan at page 2, first column, line 24 states,

"It will be noted that the screen is incorporated in the window frame as a permanent fixture.(emphasis added) Seasonal installations and removals are thus avoided."

Therefore although generally speaking Morgan may be prior art to the current invention it does not anticipate nor render obvious Applicant's claims in view of the current amendments and arguments presented herein.

In order for Morgan to anticipate Applicants claims it must be enabling and include each and every limitation of the claim elements as referenced in the excerpted case law above and in Applicant's several prior responses. All previously provided excerpted case law citations above mentioned are incorporated by reference in their entirety into this response as if they were included in their entirety herein.

It is also surmised that the Examiner may also allege the present claim set is obvious in view of Morgan. However there is no motivation to one skilled in the art to arrive at Applicants' amended claim construction from the teachings of Morgan since the teachings of Morgan lack the elements of Applicants' amended claim set.

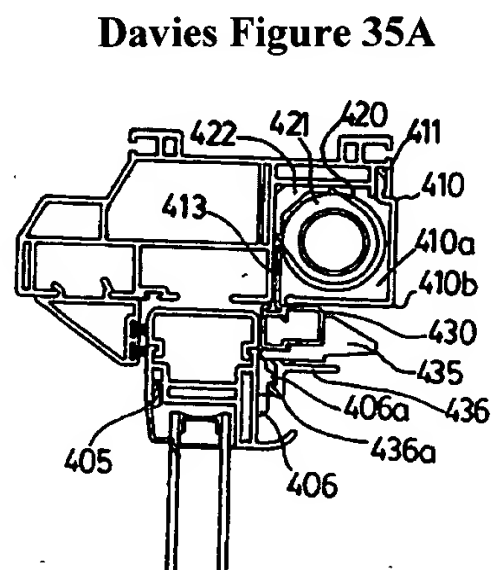
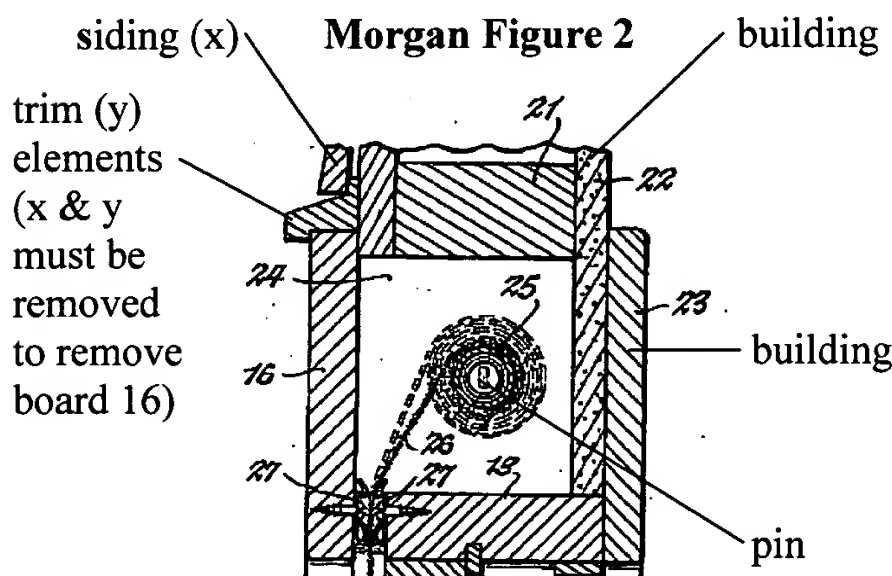
1. A window assembly comprising a window frame for supporting a window, said window frame including, a jamb having an interior, defining a jamb pocket portion containing a roll screen cassette including a retractable mesh screen having a leading edge and being carried on a spring biased roller, said cassette being contained within said jamb pocket portion, said jamb and said jamb pocket portion being an integral one piece unit manufactured when the jamb of the window frame is formed, said jamb pocket portion being defined by three sides of the interior of said jamb of the window frame, the mesh screen accumulating on and paying out from the spring biased roller of the roll screen cassette, disposed within said jamb pocket portion, wherein the roll screen cassette and the mesh

screen thereof are easily accessible in the jamb pocket for simple removal and replacement or maintenance without a need to disassemble any portions of the window frame, the window assembly and adjacent parts of a building.

Sixty-five years have past since the development of Morgan. One skilled in the art in reading Morgan today would have understood that Morgan is deficient with respect to maintenance of the screen assembly.

Applicant's invention relates to a screen assembly carried within a closure frame within a one piece integral jamb pocket formed with the jamb. Applicant's screen is readily accessible for maintenance purposes. The limitations of the claims are simply not found within Morgan. How then can Morgan anticipate or render obvious the present claim set.

In Summary:



1. (i) Morgan's header is constructed from several wooden members (13, 16, 21, 22) fastened together to enclosed the screen 25, mounted on pin P.
- (ii) Davies jamb and jamb pocket are manufactured as an integral one piece unit which results in ease of installation of the mesh screen, and access thereto in a closure assembly.
2. (i) Morgan can only be maintained with considerable difficulty if justified and at considerable expense. The trim parts, seals and screens must be removed as set out in Mr. Davies declaration.

(ii) Davies is designed to be easily installed and maintained.

Applicants have therefore addressed all the issues raised by the Examiner in his report of May 25, 2006 and full consideration of the amended claim set for the reasons set out above is requested.

If the Examiner has any questions, he is requested to contact Neil H. Hughes at (905) 771-6414 at his convenience.

Respectfully submitted,

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NHH/lvp
Encls. Declaration of John Robert Davies
Request for Extension (with fee)